

REMARKS

The office action has been carefully considered and claim 11 has been amended to incorporate the subject matter of claim 12 which was only objected to and which the examiner indicated would be allowable if rewritten in independent form including the limitations of the base claim and any intervening claims.

It is noted that the rejection of claims 1-4, 7, 10, 13, 18-23, 27 and 28 as being anticipated by Gress has been maintained. While the examiner has provided a lengthy explanation of the rejection, the comments basically group all of these claims together and ignore the nuances present in the claims. For example, the examiner fails to even mention or otherwise discuss claim 27 for which a compelling argument was made and will be repeated. How fair is the process, when arguments are simply ignored?

With regard to the examiner's response to applicants' arguments, it is truly amazing that the examiner relies upon CCPA cases from 1951 and 1976 and rejects current Federal Circuit precedent. Moreover, it is truly amazing that the examiner does not acknowledge that the object that is set forth in the preamble of claim 1, for example, is referred to in both elements of the claim and is instrumental in the functionality of the top frame and folding mechanism. It is submitted that nothing in the structure and operation of the top frame as well as the folding mechanism has anything to do with the purpose or intended use either -- the claim language recites the structure and functionality of the stand, i.e., how it works.

The examiner also indicates that the features upon which applicant relies, i.e., the object and orientation of the object are not recited in the rejected claims.

Applicants dispute this conclusion. As set forth in claim 1, for example, the weight of the object provides a substantial portion of the necessary force needed to pivot said first and second pairs of members to further separate said forward contact point from said rear wheels and move said stand from said closed position to said open position wherein said top frame planar portion is substantially horizontal. The weight of an object is important, *but the orientation of the object is necessarily the same as that of the top frame in either the open or closed position.* The elongated normally horizontally oriented object when it is open would necessarily have a top frame that is horizontally oriented and if the top frame moves to a vertical orientation when closed, so would the object move to the vertical orientation. It is inherent and inescapable.

A reason that the object is not specifically claimed is that an infringer who sold the stand without a saw would not be a direct infringer. A patentee should not have to be burdened with that circumstance, particularly when it should not be required.

The examiner again states that Fig. 4 shows the object in a vertical orientation when it clearly is not. It's at a 45° angle and the patent itself states that the extension 80 restrains tilting displacement and thus avoids the potential damage to the machine and/or injury to a workman which could occur if such tilting were not so restrained. It is frustrating to prosecute applications when examiners so blatantly mischaracterize prior art to the point of intellectual dishonesty.

With regard to the rejection of claims 1 and 14-16 as being anticipated by Cunningham, Cunningham clear does not anticipate, teach or suggest claim 1 because it

does not have a folding mechanism with first and second members as claimed with said first and second members being pivotally connected to one another and configured so that *the weight of the object provides a substantial portion of the necessary force needed to pivot said first and second pairs of members to further separate said forward contact point from said rear wheels and move said stand from said closed position to said open position wherein said top frame planar portion is substantially horizontal.* Cunningham simply does not function in this manner.

As mentioned in applicant's prior amendment, it is believed that the 102(b) rejection as being anticipated by Gress has been maintained because of the failure of the examiner to correctly interpret the language of the claims and particularly the language of the preamble and its interrelation with the elements of the claim. This is evident from the examiner's response to arguments in which he states that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure and where the body of the claims does not depend on the preamble for completeness but instead the process steps or structural limitations are able to stand alone. This statement of the law is grounded in the ancient cases of *In re Hirao* and *Kopra v. Rob*. While not overruled, there has been a body of law established by the Court of Appeals for the Federal Circuit that provides more insight and guidance including cases that have more recently addressed the issue.

In *NTP, Inc. v. Research In Motion, Ltd.* 418 F.3d 1282, 1305-1306 (Fed. Cir. 2005) the Court of Appeals for the Federal Circuit very recently restated the law regarding the preamble of a claim and its relationship to its body:

Under our precedent, a preamble generally limits the claimed invention if it “recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim.” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed.Cir.2002) (internal quotation marks omitted). Thus, if the preamble helps to determine the scope of the patent claim, then it is construed as part of the claimed invention. *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed.Cir.1995) (“[W]hen the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.”). “When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.” *Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed.Cir.2003); see also *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1350 (Fed.Cir.1998) (“[A] preamble usually does not limit the scope of the claim unless the preamble provides antecedents for ensuing claim terms and limits the claim accordingly.”).

It is clear from the above recitation that the emphasis leans toward a preamble limiting the claimed invention rather than not. The claim language of amended claim 1 here clearly demonstrates that the preamble recites essential structure and is necessary to give life, meaning and vitality to the claim. The preamble of claim 1 states a collapsible rolling stand for use with an elongated normally horizontally oriented object attached thereto and further states that the object is generally vertically oriented when the stand is closed and wherein the object is generally horizontally oriented when the stand is in its open position. The elements of the body of the claim define a top frame having a generally planar portion being configured to have the objects secured thereto, with the top frame planar portion having an orientation in a generally horizontal position when the stand is in its open position and a vertical position when the stand is moved to its closed position. Further, the stand also comprises a folding mechanism as defined and has the recitation that said first and second members are pivotally connected to one another and configured so that the weight of the object provides a substantial portion of the necessary force needed to pivot said first and second pairs of members to further separate said forward contact point from said rear wheels and move said stand from said closed position to said open position where the top frame planar portion is substantially horizontal.

This structure and functionality described in the positive elements of the claim are integrally connected and interrelated to the recitations of the preamble. There is no doubt whatsoever that the elements of the claim are not able to stand alone without

the preamble. It absolutely defies logic and common sense to conclude that the body of the claim does not depend on the preamble for completeness.

When the structure and functionality of the stand are considered in their totality, there is no doubt whatsoever that Gress fails to anticipate, teach or suggest the subject matter of amended claim 1.

While Gress has a broadly similar appearance and is directed to a foldable stand for a threading machine, it fails to anticipate, teach or suggest claim 1 because it operates substantially differently than the stand set forth in claim 1. Claim 1 is directed to a collapsible rolling stand for use with an elongated normally horizontally oriented object attached thereto, said stand being supported by a ground surface and having a front end portion and a rear end portion, and being capable of being manipulated between open and closed positions, wherein the object is generally vertically oriented when the stand is closed, and wherein the object is generally horizontally oriented when the stand is in its open position.

This preamble in and of itself distinguishes over Gress as Gress has its object, which is the threading machine generally horizontally oriented in *both* the open and closed positions. The closed position is shown in Fig. 3 where it is virtually in the same position as when it is opened which is shown in Fig. 2.

Moreover, Fig. 4 illustrates that there are projections 80 which are described to "extend from the wheels in the rearward direction with respect to the working end of the threading machine 12 and are closely spaced and generally parallel to

underlying surface S. Accordingly, should a workman introduce a work piece W into the threading machine which would extend to the left of the machine as seen in Fig. 2 to such an extent that the weight of the workpiece would tend to tilt the stand and threading machine counterclockwise relative to the axis of wheel axis 64, *projections 80 will engage the underlying surface as to restrain such tilting displacement* and thus avoid potential damage to the machine and/or injury to a workman which could occur if such tilting were not so restrained.” This is set forth in column 8, lines 48-62.

Clearly, the design of Gress is to **prevent** the object from reaching a vertical orientation. Not only is this distinction made in the preamble of claim 1, but the stand is stated to comprise, *inter alia*, “a folding mechanism supporting said top frame, including . . .first members . . . and . . .second members. . . said first and second members being pivotally connected to one another and configured so that the weight of the object provides a substantial portion of the necessary force needed to pivot said first and second pairs of members to further separate said forward contact point from said rear wheels and move said stand from said closed position to said open position wherein said top frame planar portion is substantially horizontal.”

Since the Gress object is never generally vertically oriented when the stand is closed, it cannot anticipate, teach or suggest a folding mechanism as defined in this claim. Moreover, it simply does not operate in the manner of the stand set forth in claim 1. Gress has a hand crank 40 that is used to fold and unfold the stand as is described at column 7, line 25-49 and column 8, lines 21-47. In fact, in column 8, lines 30-37, it is

described that it is advantageous that the jackscrew arrangement enables the threading machine to be elevated to any desired position above the underlying support surface up to the position shown in Fig. 2 so as to provide a working position most suitable to a given workman. This clearly indicates that there is no movement between a vertical orientation of the object when the stand is in the closed position and a horizontally oriented object when the stand is in its opened position.

Claim 27 has been amended to place it in independent form and also further defines the stand in language wherein said first and second members are configured so that the weight of the object provides a substantial portion of the necessary force needed to pivot said first and second pairs of members to move said stand **from said open position to said closed position** where said top frame portion is in a generally vertical orientation as well as during moving said stand **from said closed to said open position**. This is clearly supported by the language set forth above from pages 4 and 5 of the specification and indicates that the configuration is such that a user is not required to exert more than a small force to move the stand between its opened and closed positions. This feature is similarly claimed in allowable claim 14 which has been amended to more properly depend from claim 1.

Claim 28 has been added which is similar to claim 1 in many respects and the arguments that have been made with regard to the allowability of claim 1 are believed to equally apply to claim 28. Applicants respectfully request that this claim be allowed.

The arguments that have been advanced with regard to allowability of claim 1 equally applies to claim 20. Moreover, the dependent claims necessarily include the subject matter of the claims from which they depend, in addition to reciting other features not found in those claims and for these reasons, it is strongly believed that the dependent claims are neither anticipated, taught nor suggested by Gress, applied singularly or in combination with any other art of record and reconsideration and allowance of these claims is respectfully requested.

Reconsideration and allowance of all claims is respectfully requested.

Respectfully submitted,

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February 20, 2007
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